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EXAMINER				
CHAWLA, JYOTI				
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1781				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/784,980

**Applicant(s)**

BELL ET AL.

**Examiner**

JYOTI CHAWLA

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 4, 6-36 and 46-57 is/are pending in the application.
- 4a) Of the above claim(s) 10-27 and 46-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6-9, 28, 30, 31, 33-36 and 55-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Inventor's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/15/2010 has been entered. Claims 1, 3, 4, 6-36 and 46-57 are pending in the application. Claims 10-27 and 46-54 have been withdrawn from further consideration as being directed to a non-elected invention. Claims 1, 28 and 55 have been amended. Claims 1, 3-4, 6-9, 28, 30-31, 33-36 and 55-57 are examined in the present office action.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: the recitation of "in the form a tingling sensation" in line 8 of the claim 1 should be changed to "in the form of a tingling sensation" (Emphasis added). Appropriate correction is required.

Claims 3 and 30 are objected because of the following informalities:

The claims depend from cancelled claims: claim 3 depends on claim 2, which has been cancelled; similarly claim 30 depends on claim 29, which is also cancelled. For the purpose of expediting the examination claim 3 and 30 will be regarded as depending from independent claims 1 and 28 respectively. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**1) Claims 1, 3-4, 6-9, 28, 30-31, 33-36 and 55-57 are rejected under 35 U.S.C. 103(a) as unpatentable over Carpenter (US 5637344), in view of the combination of Raymont (AU-A-71904/96), and Seang (WO 94/05260).**

Regarding claims **1, 3, 28, 30, 55** Carpenter teaches a hard boiled candy composition comprising (or consists essentially of):

Regarding step (a) of independent claims **1, 28 and 55**, Carpenter teaches a confectionery base comprised of a mixture of at least one sugar (Carpenter, column 6,

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lines 20-28) and at least one carbohydrate bulking agent (Carpenter, column 6, lines 33-35) which is kept in an amorphous or glassy condition (Carpenter, column 2, lines 55-61).

Regarding step (b) of claims **1, 28 and 55 and claims 3 and 30**, Carpenter discloses at least one botanical (e.g., cocoa powder, see Column 2, lines 65-67) having an unpleasant mouthfeel; however, Carpenter is silent as to the botanical being one from the list provided in amended claim 1, 28 and 55, i.e., botanical is selected from the group consisting of "Echinacea, Siberian Ginseng, Ginko Biloba, Kola Nut, Goldenseal, Golo Kola, Schizandra, Elderberry, St. Johns Wort, Valerian and Ephedra, and combinations thereof". Regarding claims 1, 3, 28, 30, 55, Raymont teaches a lozenge composition (page 3, lines 30-31), i.e., a confection composition, which comprises at least one botanical, wherein the botanical may be Echinacea and Ginko Biloba (page 3, lines 19-20). Thus, confections including hard confections with botanicals, such as, Echinacea, were known in the art at the time of the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carpenter and include botanicals such as, Echinacea or Ginko Biloba. One of ordinary skill would have been motivated to modify Carpenter at least for the purpose of deriving known benefits of botanicals, such as, Echinacea for the stimulation of immune system (see Raymont, page 5, lines 20-25) and Ginko Biloba for the stimulation of circulatory system (see Raymont, page 5, lines 20-25).

The newly added limitation to the independent claims **1, 28 and 55** of "unpleasant mouthfeel in the form of tingling sensation or astringency characteristic of said group of botanicals" is associated with botanicals "Echinacea, Siberian ginseng, Ginko Biloba, Kola Nut, Goldenseal, Golo Kola, Schizandra, Elderberry, St. John's wort, Valerian and Ephedra and combinations thereof", i.e., if any or a combination of above listed botanicals are present in a confection or food product, said botanicals will inherently contribute an unpleasant mouthfeel in the form of a tingling sensation or astringency characteristic of said group of botanicals to the confection or food product as claimed. It is noted that the newly added limitation of "having an unpleasant mouthfeel in the form

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of tingling sensation or astringency characteristic of said group of botanicals" (See e.g., lines 8-9 of claim 1, also part of independent claims 28 and 55) is inherent if the group of botanicals (as claimed) is present.

Thus, the rejection of step b) over Carpenter in view of Raymont meets the newly added limitation.

Regarding step (c) of claims **1, 28 and 55 and claims 56-57**, Carpenter teaches of partially hydrogenated vegetable oils or saturated fats in an amount of less than 5% or more than 3% based on the type of confection (Carpenter, column 9, lines 1-6) where saturated fat may be cocoa butter or butter as recited in claims 1, 28, 55-57 (see Carpenter, column 6, lines 58-67 and Column 7, lines 1-7) which includes values that overlap applicant's claimed range of from about 0.5% to about 5.0% by weight, as recited in claims 1, 28 and 55. It is noted that the recitation wherein the agent is "an unpleasant mouthfeel suppressing agent for suppressing the tingling sensation or astringency characteristic of said group of botanicals" and said amount "being effective to suppress said unpleasant mouthfeel" of said botanical are a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case given that the amount of hydrogenated vegetable oils or saturated fats taught by Carpenter falls in the recited range (Column 6, lines 58-67 and Column 7, lines 1-7), it follows that the prior art (i.e., Carpenter as described above) structure is capable of performing the intended use, i.e., an unpleasant mouthfeel suppressing agent for suppressing the tingling sensation or astringency characteristic of said group of botanicals and said amount being effective to suppress said unpleasant mouthfeel".

Regarding the overlapping of ranges between the invention and prior art composition it is noted that in the case where the claimed ranges "overlap or lie inside the ranges disclosed by the prior art" a prima facie case of obviousness exists (In re Wetheim, 541

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F2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990)).

Further, Regarding the limitation of utilizing partially hydrogenated vegetable oils or saturated fats as unpleasant mouthfeel suppressing agent, Seang teaches that lipids (oils and fats) were known for masking the bitter taste (i.e., unpleasant mouthfeel) (Seang, Page 1, line 28, Page 4, lines 6-15, 35-37; Page 5, lines 5-7; Page 6, lines 5-15). Thus, effect of lipids in masking the unpleasant mouthfeel was known at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention that the partially hydrogenated vegetable oils or saturated fats in applicants' recited range, as taught by Carpenter will suppress the unpleasant mouthfeel of botanical in a similar manner as the partially hydrogenated vegetable oils or saturated fats in the instantly claimed invention.

Regarding type of fats, Carpenter teaches of fat derived from vegetable sources including corn oil, soybean oil, peanut oil, palm oil, sunflower oil, and also teaches of hydrogenated vegetable oils (Column 7, lines 1-6). Carpenter also teaches that the saturated fat may be cocoa butter or butter (Column 6, line 67 to Column 7, line 2) as recited in claims 1, 28, 56-58. However the reference is silent about the specific examples of partially hydrogenated vegetable oils or fats being selected from cottonseed, soybean, peanut, palm, sunflower or corn oil as recited in **claims 4 and 31**. However, addition of partially hydrogenated form of fats was well known in the art, for example, Seang teaches of partially hydrogenated vegetable oils including cottonseed oil (Page 6, lines 1-15) for the purpose of masking the effect of an unpleasant flavor. Thus, addition of partially hydrogenated and saturated fats to mask the flavor or suppress the mouthfeel of botanicals was known in the art at the time of the invention and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carpenter in view of Seang and utilize a partially hydrogenated vegetable oil, such as cottonseed oil, in the confection composition. One of ordinary skill would have been motivated to do so at least for the purpose of substituting one type of

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saturated fat for another type of saturated fat in the instantly claimed invention based on the availability of the fat.

Further it is noted that saturated fats, such as, cocoa butter or butter, and hydrogenated vegetable oil (, i.e., an oil that has been hydrogenated to convert the unsaturated into saturated fats), such as cottonseed oil will act similarly in a hard confection as disclosed by Carpenter, i.e., cocoa butter and butter of Carpenter are functional equivalents of partially hydrogenated cottonseed oil of Seang. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute one art recognized functional equivalent (i.e. partially hydrogenated cottonseed oil, saturated fat disclosed by Seang) for another (i.e. cocoa butter or butter, saturated fats taught by Carpenter) in the confection as disclosed by Carpenter, depending on which saturated fat was more easily available and affordable at the time the invention was made.

The Courts have held that the selection of a known material, which is based upon its suitability for the intended use, is within the ambit of one of ordinary skill in the art. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) (see MPEP § 2144.07).

Regarding claims **6, 7, 33 and 34**, Carpenter teaches that the saturated fat or partially hydrogenated vegetable oil may be present at greater than about 3% and less than 5% (Column 9, lines 1-6), which falls in the recited ranges of 0.5% to 3.5% (for claims 6 and 33) or 0.75% to 3.0% (for claims 7 and 34). Regarding the overlapping of ranges between the invention and prior art composition it is noted that in the case where the claimed ranges "overlap or lie inside the ranges disclosed by the prior art" a prima facie case of obviousness exists (*In re Wetheim*, 541 F2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990)).

Regarding claims **8, 9, 35 and 36**, Carpenter teaches that the ratio of the saturated fat or partially hydrogenated vegetable oil to the botanical is from about 1:100 to 3:1 (Col. 7, lines 40-45), which includes ratio values that falls in the recited range of ratios of 1/1 to about 1/0.01 (for claims 8 and 35) and from 1.0/0.6 to 1.0/0.15 (for claims 9 and 36).



Regarding the overlapping of ranges between the invention and prior art composition it is noted that in the case where the claimed ranges "overlap or lie inside the ranges disclosed by the prior art" a prima facie case of obviousness exists (In re Wetheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990)).

### ***Response to Arguments***

Applicant's arguments submitted 5/28/2010 regarding the rejection have been fully considered but are not persuasive.

i) Applicants' argue that Carpenter's "cocoa powder ...elicits an unpleasant mouthfeel. However, the unpleasant mouthfeel of cocoa is not chemical based, it is physical based owing to the abrasive nature of the particles of cocoa powder" (remarks, page 16, 13-15). Applicant's also argue that there is no mention in Seang that "lipids could be used to address the tingling sensation or astringency associated with the chemical based unpleasant mouthfeel of the group of botanicals in claim 1" (Remarks, page 19, lines 7 onwards). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case Carpenter, Raymont and Seang are applied in a combination in an obviousness rejection.

ii) Applicants argue that ""One of ordinary skill in the art substituting Echinacea in Carpenter would expect the same physical change to particles of Echinacea, but would recognize that the unpleasant mouthfeel will not be suppressed" (Remarks, page 18, last line to page 19, line 2). This argument is also not persuasive because the test for

obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Thus applicants' arguments against the references individually are not persuasive.

Further, in the instant case, Carpenter teaches of partially hydrogenated vegetable oils or saturated fats in an amount which overlaps applicant's claimed range of from about 0.5% to about 5.0% by weight (Carpenter, column 9, lines 1-6) where saturated fat may be cocoa butter or butter as recited in claims 1, 28, 55-57 (see Carpenter, column 6, lines 58-67 and Column 7, lines 1-7). It is noted that the recitation wherein the agent is "an unpleasant mouthfeel suppressing agent for suppressing the tingling sensation or astringency characteristic of said group of botanicals" and said amount "being effective to suppress said unpleasant mouthfeel" of said botanical are a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case given that the amount of hydrogenated vegetable oils or saturated fats taught by Carpenter falls in the recited range (Column 6, lines 58-67 and Column 7, lines 1-7), it follows that the prior art (i.e., Carpenter as described above) structure is capable of performing the intended use, i.e., an unpleasant mouthfeel suppressing agent for suppressing the tingling sensation or astringency characteristic of said group of botanicals and said amount being effective to suppress said unpleasant mouthfeel". Thus, one of ordinary skill would expect the fat content as taught by Carpenter to be effective in suppressing the tingling sensation or astringency characteristic of said group of botanicals, as claimed. See rejection of independent claims 1, 28 and 55 above.

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iii) Applicant's argument that "the unpleasant mouthfeel of cocoa is not chemical based" (remarks, page 16, 13-15) is also not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., unpleasant mouthfeel being chemical based) are not specifically recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case the claim recites "Echinacea, Siberian ginseng, Ginko Biloba, Kola Nut, Goldenseal, Golo Kola, Schizandra, Elderberry, St. John's wort, Valerian and Ephedra and combinations thereof, each having unpleasant mouthfeel" (claims 1, 28 and 55), where the nature of the unpleasantness has been claimed as "tingling sensation or astringency", which has been addressed in the rejection of claims above. Further, it is noted that the newly added limitation of "having an unpleasant mouthfeel in the form of tingling sensation or astringency characteristic of said group of botanicals" (See e.g., lines 8-9 of claim 1, also part of independent claims 28 and 55) is inherent if the group of botanicals (as claimed) is present, and the combination of references teach Echinacea and Ginko Biloba (See rejection of independent claims above).

iv) Regarding the recitation of "unpleasant mouthfeel suppressing agent consisting of one or more partially hydrogenated vegetable oils or saturated fats" and that the combination of references not teaching the invention as claimed (Remarks, page 20). However, applicant is directed to the composition as claimed, wherein the independent claims recite "hard boiled candy composition comprising" (Claim 1), "hard boiled candy composition consisting essentially of" (Claim 55) and "a method...comprising (line 1 of claim 28) (Emphasis added). Applicant is referred to MPEP 2111.03 where it is clearly stated that the transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps and that for the purpose of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the

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specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to comprising."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jyoti Chawla/  
Examiner, Art Unit 1781